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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/163,289	09/29/1998	HARRY C. DIETZ	07265/098002	9819

7590

01/24/2002

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EXAMINER
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SCHMIDT, MARY M

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 01/24/2002

26

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/163,289

Applicant(s)

DIETZ, HARRY C.

Examiner

Mary M. Schmidt

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 January 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check only a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 04 January 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (see NOTE below);
  - (b) ☐ they raise the issue of new matter. (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

4. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: 15, since it is dependent on rejected claims.
- Claim(s) rejected: 1-13
- Claim(s) withdrawn from consideration: \_\_\_\_\_
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
11. ☐ Other: \_\_\_\_\_

Continuation of 4. Applicant's reply has overcome the following rejection(s): Applicant's reply has overcome the 35 U.S.C. 112, scope of enablement rejection of claims 13 and 15. Applicant has also overcome the Double Patenting rejection over U.S. Patent 5,814,500 by filing of a Terminal Disclaimer. However, in view of the outstanding art rejection, the claims are not presently in condition for allowance.

Applicant's response has not overcome the 35 U.S.C. 102 rejection made. The rejection stands on claims 1-13 as amended. Applicant argues that the "unmodified" construct of Mickienzi does not read on the instantly claimed "unmodified" constructs. The specification teaches on page 4 that "unmodified" or "intact" stem loop structures flank the antisense nucleic acid so that the antisense nucleic acid can readily interact with any target sequence. In a preferred embodiment, the stem loop structures are U snRNA stem loops... the construct provides a cloning site outside of the stem loop structures, thus rendering the stem loop structures "unmodified," into which virtually any antisense oligonucleotide could be inserted... optionally, a ribozyme nucleic acid is included in the construct." Applicant argues that Michienzi's "unmodified" U1-Rz construct is a U1 snRNA that has a hammerhead ribozyme nucleic acid sequence inserted into the stem-loop III nucleic acid. However, this is the exact structure described by the instant specification as reiterated above. The instant specification teaches that a preferred embodiment of the "unmodified" structure is to have a U snRNA stem loop optionally with a ribozyme as the antisense inserted in said structure. Applicant's arguments are thus not considered persuasive in overcoming the instant rejection. Claim 13 as amended reads on use of the constructs of claim 1 in cells in culture. Mickienzi reads on this claim as amended since they taught use of their constructs (which read on claims 1-12) in cells in cell culture (see abstract for instance). Claim 15 is newly objected to since no outstanding art rejections apply.

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